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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/078,534	02/21/2002	Katsunori Nishimura	62807-034	3061
20277	7590	03/09/2004	EXAMINER	
MCDERMOTT WILL & EMERY 600 13TH STREET, N.W. WASHINGTON, DC 20005-3096			LE, HOA VAN	
			ART UNIT	PAPER NUMBER
			1752	

DATE MAILED: 03/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/078,534

Applicant(s)

NISHIMURA ET AL.

Examiner

Hoa V. Le

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1752

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) 4-7, 12 and 13 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-3 and 8-11 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 February 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.

- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☒ Other: Checked list.

This application is up for consideration.

A. The record shows that: the application file

(A) has:

- (1) 48 pages of specification,
- (2) 1 cover sheet, and
- (3) 11 sheets of drawing, and

(B) do not have:

- (i) priority claimed,
- (ii) certified foreign priority, and

(iii) information disclosure statement. It is apology for missing documents from the list. Please resubmit them for consideration and examination. Copy of cover sheet with its checked list is incorporated herewith

B. It is required that applicants must timely submit a proper declaration. No allowance of the application until a proper declaration is submitted.

C. Applicants are reasonably given one month to resubmit and submit papers for consideration and examination.

D. Claims 4-7 and 12-13 are improper. Accordingly, they are not considered.

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E. Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. The groups of claims (1 and 3) and (2 and 3) with broadest independent claim 1 as the main invention and others as secondary ( have not been considered to be patentably different or distinct. Accordingly, no separate consideration or search will be made. Should applicants show or urge otherwise in the next response to this Office action in order for it to be considered timely, a restriction will be made for the record as shown or urged, drawn to an electrode, classified in class 429, subclass 30.
- II. The groups of claims (8 and 11), (9 and 11) and (10 and 11) with broadest independent claim 8 as the main invention and others as secondary ( have not been considered to be patentably different or distinct. Accordingly, no separate consideration or search will be made. Should applicants show or urge otherwise in the next response to this Office action in order for it to be considered timely, a restriction will be made for the record as shown or urged, drawn to an electrode, classified in class 429, subclass 34.

The inventions of Group I and Group II are all related to the materials but have the patentably different and distinct and have acquired the separate status and searches in the art and can be supported the separate patents as divided by applicants and have no evidence on the record that is not required the separate consideration and search since they are the obvious variants because the prior art being applied to one of them would be sufficient against all inventions, restriction for examination purposes as indicated is proper. Applicant should show or

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provide an evidence to the contrary. In the absence of convincing evidence, the restriction would not be removed.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

F. Dependent claims 4-7 and 12-13 would be let to go along with their elected, considered, searched and allowable Group of the claims if they are amended to be proper.

G. A proper amount of fee must be paid before and examination is made.

H. Other issues have not been considered and will not be considered unit (1) all of the requirements as clearly pointed out and set forth on the record are met and (2) a proper election is made and resolved.

I. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hoa V. Le whose telephone number is 571-272-1332.

The examiner can normally be reached from 6:00 AM to 4:00 PM on Monday through Thursday and about the same time of most Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark F. Huff can be reached on 571-272-1385. The fax phone numbers of the examiner is 571- 273-1332. Since there is a newly electronic filing procedure for all initial

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communicating papers and all responses to an Office action, the examiner fax phone number is not for use to receive any fax in response to an Office action. Applicant is requested and required to send all initial communicating papers and all response to Office action to a central paper or fax receiving center for an electronic scanning procedure.

Applicants may file a paper by (1) fax with a central facsimile receiving number 703-872-9306,

(2) mail with a central mail receiving address:

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Hoa V. Le  
Primary Examiner  
Art Unit 1752

HVL  
05 March 2004

HOA VAN LE  
PRIMARY EXAMINER

